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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,548	03/19/2001	Aki Tomita	520.39598X00	6782

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT PAPER NUMBER

2171

DATE MAILED: 04/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,548

Applicant(s)

TOMITA ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6, are presented for examination.

Priority

2. Applicant's claim for foreign priority under 35 U.S.C. §119(a)–(d) is acknowledged. Therefor accorded the benefit date of 01 November, 2000.

Specification

3. The abstract of the disclosure is objected to because it is not in a single paragraph. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 3-6, are rejected under 35 U.S.C. 102(e) as being anticipated by Itaru Nishizawa (U.S. Patent No. 6,519,598 and Nishizawa hereinafter).

Regarding Claim 1, Nishizawa discloses:

host computer (Col 4, Line 22, i.e. *client computer 101 and 102*)

a skeleton program for instructing data format transformation (Col 8, Lines 21-22, i.e. *when the XML application¹ issues the data request 1412; see also Figure No. 6, Element No. 602, i.e. receive the data request from a client computer*)

a communication program (Figure No. 1, Element No. 106; see also Col 4, Lines 29-33, i.e. *The magnetic disk apparatus² 108 comprises a network interface for connecting the magnetic disk apparatus to the network and for assuring communication between the client computers and the data conversion program server*)

said disk storage device having (Figure No. 3, Element No. 320)

a data format transforming program³ (Figure No. 3, Element No. 316)

a communication program (Figure No. 3, Element No. 323)

said the skeleton program sending a request to said data format transformation program (Col 5, Lines 22-25, i.e. *the client issues the data request to the magnetic disk apparatus.*

¹ Please note that the Examiner is interpreting this example of the "XML Application" to be the same as the "skeleton program" as they both are programs that are requesting a conversion or a transformation.

² Please note that the Examiner is interpreting this "*magnetic disk apparatus*" to be the same as the "disk storage" of Claim No.1

³ Please note that the Examiner is interpreting the "data format transforming program" to be the same as the "data conversion" in the Nishizawa reference.

An example of the data request is shown in FIG. 10. the data request includes three designations of data output format) on said disk storage (please note that this was established earlier above, see Figure 3, Element 316) via said communication program for communicating with said disk storage, (also was established earlier above, see figure 3, Element 323) at the time of data format transformation (Figure No. 6, Element No. 607 and 608)⁴

said data format transformation program receiving the request via said communication program for communicating with the host computer (Figure No. 6, Element No. 602)

said data format transformation program performing the data format transformation within its own disk storage device (Figure No. 6, Element No. 607 and 608)⁵.

Regarding Claims 3-6, the limitations of these claims are similar in scope to the rejected claim 1, above. They are therefore rejected as set forth above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

⁴ The Examiner would like to direct the Applicant's attention to the fact that ending the data conversion process (as in Figure 6, Element 608) is an indication that this process of sending and receiving this "request" is actually happening, also Figure 6, Element 607 is another good example for showing the transformation (conversion) at the current time.

⁵ Please note the location of the data format transformation (conversion), i.e. "in the magnetic disk apparatus".

7. Claim 2, is rejected under 35 U.S.C. 103(a) as being unpatentable over Itaru Nishizawa (U.S. Patent No. 6,519,598 and Nishizawa hereinafter) in view of Takashi Suzuki (U.S. Patent No. 6,125,304 and Suzuki hereinafter).

Regarding Claim 2, the Nishizawa reference discloses all of the claimed subject matter set forth above, including the limitation of address of source data (Figure No. 9, Element No. 906, i.e. from employee), except the reference does not explicitly indicate the two limitations regarding the size of the data to be transformed and the destination address of the transformed data. However Suzuki discloses all of the three limitation, including the "address of source data", "the size of data to be transformed" and the "destination address" (Figure No. 2A, Element No. S2; see also Col 10, Lines 49-56, i.e. *a conversion source file name, a conversion destination file name, a board (PCB) size, and a flow direction are input (step S2). The operations for inputting the PCB size and the flow direction in this process are the operations with which the data of the data items such as the (6) flow direction and the (7) PCB size, which can be changed also immediately before the conversion process, are used unchanged, or the data are changed with an input if they are to be changed*). Given the intended broad application of the Nishizawa reference, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Nishizawa with the teachings of Suzuki in order to increase the flexibility of the system by presenting a system that is more user friendly by allowing the user to directly specify the source, size and the destination of the transformed data, also to increase the process efficiency of the system.

Other Prior Art Made of Record

8. a. Weerawarana et al. (U.S. Patent No. 6,408,299) discloses a type convertor registry; and

b. Nagatomo et al. (U.S. Patent No. 6,334,126) discloses a data output system, communication terminal to be connected to data output system, data output method and storage medium.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Points of Contact

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

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Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at
our fax number (703) 746-7238 or (703) 746-7239 or (703) 746-7240.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th
Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

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Technology Center 2100
April 15, 2003


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